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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,585	11/27/2001	Douglas Levinson	10436-0015-999	7294

20583 7590 05/01/2003

PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/01/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,585

Applicant(s)

Levinson

Examiner

Maurie G. Baker

Art Unit

1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1639 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to an array, classified variously, for example, in class 435, DIG 34.
 - II. Claims 15-28, drawn to a method of making an array, classified variously, for example, in class 435, DIG 46.
 - III. Claims 29-50, drawn to a method of screening, classified variously, for example, in class 435, DIG 14.
 - IV. Claims 51-65, drawn to a method to discover conditions, compounds or compositions that prevent or inhibit crystallization, precipitation, polymerization or deposition, classified variously, for example, in class 435, DIG 14 *OR* class 436, subclasses 147, 148 or 174+.
 - V. Claims 66-80, drawn to a method to discover conditions, compounds or compositions that promote dissolution, destruction or breakup, classified variously, for example, in class 435, DIG 14 *OR* class 436, subclasses 147, 148 or 174+.
2. The inventions are distinct, each from the other because of the following reasons:

3. Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, The array could be made by another and materially different process, such as, by combinatorial synthesis.

4. Groups I and III – V are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the array of Group I could be used for structure activity screening or as starting materials for synthesis of further modified arrays.

5. Groups II – IV are different methods. The methods are different because they use different steps, reagents and/or will produce different results/products. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the method of Group II differs from Groups III – V because they have completely different end results. The method of Group II is a method for *preparing* an array while the methods of Groups III – V are methods for *screening* arrays. Moreover, Groups III – V are different, each from the other, because the end results of the screening is different for each method (identification of different entities).

6. Therefore, the groups that describe these inventions each have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Each group could support a separate patent.

7. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. Please note that even though some of these groups could be classified in the same class/subclass, this has no effect on the non-patent literature search. The different methods would require completely different searches in these databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

Election of Species

8. This application contains claims directed to patentably distinct species of the claimed invention for **all of Groups I – V.** Election is required as follows.

9. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Claims 1, 10 and 11 are generic. Election is required from *each* species and subspecies below.

Species 1: Samples (all components)

A *single, specific* species of samples in the claimed array should be elected, for purposes of search. All components thereof should be defined as follows:

- A. A single form of the sample (e.g. claim 3) and specific “disease-causing substance” (e.g. claim 14) should be elected.
- B. The specific type of medium should also be set forth.
- C. If all samples in the array do not comprise the same “disease-causing substance”, then the identity of each should be set forth.
- D. If an “additional component” is present (i.e. claim 7), it should also be *specifically* elected.

Species 2: Difference between samples

A *single, specific* species of difference between samples should be elected, for purposes of search, from the following:

- A. Identity of components
- B. Amount of components
- C. Physical state of components
- D. Identity of medium
- E. Amount of medium
- F. pH
- G. Gas composition
- H. Temperature

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably distinct species. Claims 15, 16, 24 and 25 are generic. Election is required from *each* species and subspecies below.

Species 1: Samples (all components)

A *single, specific* species of samples used in the claimed method should be elected, for purposes of search. All components thereof should be defined as follows:

- A. A single form of the sample (e.g. claim 19) and specific “disease-causing substance” (e.g. claim 28) should be elected.
- B. The specific type of medium should also be set forth.

- C. If all samples in the array do not comprise the same “disease-causing substance”, then the identity of each should be set forth.
- D. If an “additional component” is present (i.e. claim 21), it should also be *specifically* elected.

Species 2: Processing of samples

A *single, specific* species of processing should be elected, for purposes of search, from the following:

- A. Adjusting time of incubation
- B. Adjusting temperature
- C. Adjusting pressure
- D. Subjecting to nucleation event
- E. Subjecting to ultrasound, shock waves, laser energy or mechanical stimulation
- F. Adjusting amount of component
- G. Adding component
- H. Adjusting amount of medium
- I. Adjusting gas composition

Species 3: Difference between samples

A *single, specific* species of difference between samples should be elected, for purposes of search, from the following:

- A. Identity of components
- B. Amount of components
- C. Physical state of components
- D. Identity of medium
- E. Amount of medium
- F. pH

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

11. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claims 29 and 46-50 are generic. Election is required from *each* species and subspecies below.

Species 1: Samples (all components)

A *single, specific* species of samples used in the claimed method should be elected, for purposes of search. All components thereof should be defined as follows:

- A. A single form of the sample (e.g. claim 30) and specific “disease-causing substance” (e.g. claim 40) should be elected.
- B. The specific type of medium should also be set forth.
- C. If all samples in the array do not comprise the same “disease-causing substance”, then the identity of each should be set forth.
- D. If an “additional component” is present (i.e. claim 33), it should also be *specifically* elected.

Species 2: Processing of samples

A *single, specific* species of processing should be elected, for purposes of search, from the following:

- A. Adjusting time of incubation
- B. Adjusting temperature
- C. Adjusting pressure
- D. Subjecting to nucleation event
- E. Subjecting to ultrasound, shock waves, laser energy or mechanical stimulation
- F. Adjusting amount of component
- G. Adding component
- H. Adjusting amount of medium
- I. Adjusting gas composition

Species 3: Difference between samples

A *single, specific* species of difference between samples should be elected, for purposes of search, from the following:

- A. Identity of components
- B. Amount of components
- C. Physical state of components
- D. Identity of medium
- E. Amount of medium
- F. pH
- G. Gas composition

Species 4: Detection

A *single, specific* species of detection should be elected, from those set forth in claims 42-45, for purposes of search.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them

out. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

12. If applicant elects the invention of **Group IV**, applicant is required to elect from the following patentably distinct species. Claims 51, 57, 58 and 63-65 are generic. Election is required from *each* species and subspecies below.

Species 1: Samples (all components)

A *single, specific* species of samples used in the claimed method should be elected, for purposes of search. All components thereof should be defined as follows:

- A. A single form of the sample and specific "disease-causing substance" (e.g. claim 62) should be elected.
- B. The specific type of medium should also be set forth.
- C. If all samples in the array do not comprise the same "disease-causing substance", then the identity of each should be set forth.
- D. If an "additional component" is present (i.e. claim 54), it should also be *specifically* elected.

Species 2: Processing of samples

A *single, specific* species of processing should be elected, for purposes of search, from the following:

- A. Adjusting time of incubation
- B. Adjusting temperature
- C. Adjusting pressure
- D. Subjecting to nucleation event
- E. Subjecting to ultrasound, shock waves, laser energy or mechanical stimulation
- F. Adjusting amount of component
- G. Adding component
- H. Adjusting amount of medium
- I. Adjusting gas composition

Species 3: Difference between samples

A *single, specific* species of difference between samples should be elected, for purposes of search, from the following:

- A. Identity of components
- B. Amount of components
- C. Physical state of components

- D. Identity of medium
- E. Amount of medium
- F. pH
- G. Gas composition

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

13. If applicant elects the invention of **Group V**, applicant is required to elect from the following patentably distinct species. Claims 66, 73, 74 and 78-80 are generic. Election is required from *each* species and subspecies below.

Species 1: Samples (all components)

A *single, specific* species of samples used in the claimed method should be elected, for purposes of search. All components thereof should be defined as follows:

- A. A single form of the sample and specific “disease-causing substance” (e.g. claim 77) should be elected.
- B. The specific type of medium should also be set forth.
- C. If all samples in the array do not comprise the same “disease-causing substance”, then the identity of each should be set forth.
- D. If an “additional component” is present (i.e. claim 70), it should also be *specifically* elected.

Species 2: Processing of samples

A *single, specific* species of processing should be elected, for purposes of search, from the following:

- A. Adjusting time of incubation
- B. Adjusting temperature
- C. Adjusting pressure
- D. Subjecting to nucleation event
- E. Subjecting to ultrasound, shock waves, laser energy or mechanical stimulation
- F. Adjusting amount of component
- G. Adding component
- H. Adjusting amount of medium

I. Adjusting gas composition

Species 3: Difference between samples

A *single, specific* species of difference between samples should be elected, for purposes of search, from the following:

- A. Identity of components
- B. Amount of components
- C. Physical state of components
- D. Identity of medium
- E. Amount of medium
- F. pH
- G. Gas composition

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

14. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
15. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon***, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
16. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

17. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

18. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

20. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the

merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
April 24, 2003

A handwritten signature in black ink, appearing to read 'MGB', followed by a long horizontal line extending to the right.

MAURIE GARCIA BAKER, Ph.D.
PRIMARY EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1639

SERIAL NUMBER:

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